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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/465,147	12/16/1999	JAMES E. GRIMES	30-GF-1083	8528

7590

03/22/2004

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EXAMINER

PEIKARI, BEHZAD

ART UNIT

PAPER NUMBER

2186

DATE MAILED: 03/22/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

Office Action Summary

Application No.

09/465,147

Applicant(s)

GRIMES ET AL.

Examiner

B. James Peikari

Art Unit

2186

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 25-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24, 35 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. On page 9 of the remarks submitted with the amendment of March 1, 2004, applicant has traversed the restriction requirement made in the previous Office action. The traversal does not comply with the requirement of 37 CFR § 1.111 or MPEP 818.03(a) in which "applicant is required to specifically point out the reasons on which he or she bases his or her conclusions that a requirement to restrict is in error." Thus, the required election becomes an election without traverse.

In any case, the requirement is still deemed proper and is therefore made FINAL.

As to the amendments to claims 25, 26, 30 and 31, these amendments are to claims that have already been withdrawn from consideration. Consequently, these amendments are considered untimely and have not been entered. The cancellation of claims 27 and 32 has been entered.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed March 1, 2004 has been entered.

Drawings

3. The previous objections to the drawings are withdrawn due to the amendment filed on March 1, 2004.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "external device, coupled to the memory host module" must be shown or the feature(s) canceled from the claim(s).

No new matter should be entered. Since nothing in the specification supports an external device actually coupled to the memory host module (see below), entry of this feature in the drawings would be considered new matter.

A proposed drawing correction or corrected drawings or appropriately amended claims are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

5. The previous objections to claims 22 and 23 are withdrawn due to the amendment filed on March 1, 2004.

Claim Rejections - 35 USC § 112

6. Claims 1-24 and 35-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claims recite “storing a plurality of operating programs and data including a first and second operating program and data in the external device coupled to the memory host module”, however, this external device is not taught in the specification.

The specification mentions removable memory, but this is not an external device because applicant treats it as part of the memory host module on page 3, “memory 22 in memory host module 1 can be a removable memory 30”. Alternatively, applicant refers to “an external system (not shown)” on page 3, but never mentions that it is coupled to the memory host module. In fact, applicant suggests otherwise by requiring the removable memory stored in the external system to be installed in memory host module 12 by the PLC user.

Claim Rejections - 35 USC § 102

7. The previous rejections under 35 U.S.C. 102(b) are withdrawn due to the amendment filed on March 1, 2004.

Response to Amendment

8. The amendment filed on March 1, 2004 has been carefully considered, but is not deemed to place the application in condition for allowance.

The previous rejection based on the Sexton reference has been overcome by the new claim language. However, since the new claim language is rejected under 35 U.S.C. 112, first paragraph, the prior art rejection may be repeated in a later stage of prosecution, should the new claim language be amended or removed.

Since the basis of the critical claim feature "storing a plurality of operating programs and data including a first and second operating program and data in the external device coupled to the memory host module" is absent, no prior art rejection of claims containing this feature is deemed necessary at this time.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Peikari whose telephone number is (703) 305-3824. The examiner is generally available between Monday through Thursday, 8:00 am and 9:00 pm, EST, and on weekends.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Kim, can be reached at (703) 305-3821.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Art Unit: 2186

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(703) 746-7239 (Official communications)

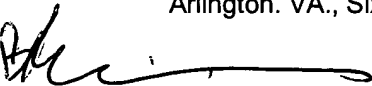
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(703) 746-7240 (for Informal or Draft communications)

or:

(703) 746-7238 (for After-Final communications)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).



B. James Peikari
Primary Examiner
Art Unit 2186

March 12, 2004